



IFW

Docket No.: 0425-1266PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Toshimitsu UENAKA et al.

Application No.: 10/586,536

Confirmation No.: 1635

Filed: July 19, 2006

Art Unit: N/A

For: ASSAY METHOD TO PREDICT
SENSITIVITY OF CANCER CELL TO
ANTICANCER DRUG

Examiner: Not Yet Assigned

INFORMATION DISCLOSURE STATEMENT
(SUBMISSION AFTER FILING OF AN APPLICATION BUT BEFORE FINAL
REJECTION OR NOTICE OF ALLOWANCE OR CONCURRENTLY WITH A RULE
1.114 RCE APPLICATION)

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §§ 1.97 and 1.98, applicant(s) hereby submit(s) an Information Disclosure Statement for consideration by the Examiner.

I. LIST OF PATENTS, PUBLICATIONS OR OTHER INFORMATION

The patents, publications, or other information submitted for consideration by the Office are listed on the PTO-SB08(s), attached hereto.

II. COPIES

- ☒ a. Copies of cited U.S. patents and patent application publications are not included.
Copies of foreign patent documents and non-patent literature are included.

☐ b. Some or all of the documents listed on the PTO-SB08 are not enclosed because they were cited in the International Search Report and copies should already be in the PTO file. If copies are needed, please contact the undersigned.

☒ c. REFERENCES PREVIOUSLY CITED OR SUBMITTED - Pursuant to 37 C.F.R. §1.98(d), consideration of information listed on the PTO-SB08 form(s) is requested since any patents, publications, or other information which are listed on the PTO-SB08 form(s) but for which copies are not enclosed herewith, were previously cited by or submitted to the PTO in one of the following applications which has been relied upon for an earlier filing date under 35 U.S.C. § 120:

U.S. Appl. No(s) and U.S. Filing Date

PCT/JP2005/002091 filed February 4, 2005

III. CONCISE EXPLANATION OF THE RELEVANCE

(check at least one box)

☒ a. DOCUMENTS IN THE ENGLISH LANGUAGE - The patents, publications, or other information listed on the attached PTO SB08 are in the English language and therefore, do not require a statement of relevancy.

☒ b. DOCUMENTS NOT IN THE ENGLISH LANGUAGE - A concise explanation of the relevance of all patents, publications, or other information listed that is not in the English language is as follows: English language Abstracts are provided herewith for WO 02/42493, WO 2004/011661, WO 03/099813, and WO 02/060890. EP 1336660 is in the English language and is in the same patent family as WO 02/42493. EP 1508570 is in the English language and is in the same patent family as WO 2003/099813. EP 1380579 is in the English language and is in the same patent family as WO 02/060890. WO 2004/011661, WO 03/099813, and WO 02/060890 are discussed in the specification at page 3, lines 16-17. Reference CH is discussed in the specification at page 2, line 2. Reference CA is discussed in the specification at page 2, lines 22-23. Reference CB is discussed in the specification at page 2, line 9. Reference CC is

discussed in the specification at page 3, line 8. Reference CD is discussed in the specification at page 2, line 8. Reference CE is discussed in the specification at page 2, line 7. Reference CF is discussed in the specification at page 2, line 26.

☒ c. ENGLISH LANGUAGE SEARCH REPORT - An English language version of the search report or action that indicates the degree of relevance of references BA-BD and CG found by the foreign office was previously submitted with the application materials on July 19, 2006, thereby satisfying the requirement for a concise explanation of these 5 documents. See MPEP 609(III)(A)(3).

☐ d. OTHER - The following additional information is provided for the Examiner's consideration.

IV. FEES (check one box)

☐ a. This Information Disclosure Statement is being filed concurrently with the filing of a new patent application; therefore, no fee is required.

☐ b. This Information Disclosure Statement is being filed concurrent with the filing of a continuation-in-part, continuation, or divisional patent application; therefore, no fee is required.

☒ c. This Information Disclosure Statement is being filed within three months of the filing date of a national application (37 C.F.R. § 1.97(b)(1)). No fee or statement is required.

☐ d. This Information Disclosure Statement is being filed within three months of the date of entry of the national stage as set forth in § 1.491 in an international application (37 C.F.R. § 1.97(b)(2)). No fee or statement is required.

☐ e. This Information Disclosure Statement is being filed concurrently with the filing of a Request for Continued Examination under § 1.114 (37 C.F.R. § 1.97(b)(4)). No fee or statement is required.

☐ f. This Information Disclosure Statement is being filed before the mailing date of a first Action on the merits (37 C.F.R. § 1.97(b)(3)). No fee or statement is required. In the event that a first Office Action on the merits has been issued, please consider this IDS under 37 C.F.R. § 1.97(c) and see the statement under 37 C.F.R. § 1.97(e) below, or, if no statement has been made, charge our deposit account for the fee as required by 37 C.F.R. § 1.17(p).

☐ g. This Information Disclosure Statement is being filed before the mailing date of a Final Office Action under 37 C.F.R. § 1.113 (See 37 C.F.R. § 1.97(c)(1)) or before the mailing date of a Notice of Allowance under 37 C.F.R. § 1.311 (See 37 C.F.R. § 1.97(c)(2)).

☐ No statement; therefore, a fee as required by 37 C.F.R. § 1.17(p) is attached.
or

☐ See the statement below. No fee is required.

V. STATEMENT UNDER 37 C.F.R. § 1.97(e)

(check only one box)

The undersigned hereby states that:

☐ a. **Each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than 30 days prior to the filing of this IDS; or**

☐ b. Each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS; or

☐ c. No item of information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of IDS was known to any

individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS.

☐ d. Some of the items of information were cited in a communication from a foreign Patent Office. As to this information, the undersigned states that each item of information contained in the IDS was first cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS. As to the remaining information, the undersigned hereby states that no item of this remaining information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application and, to the best of my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this statement.

VI. PAYMENT OF FEES (check one box)

☐ The required fee is listed on the attached Fee Transmittal.

☒ No fee is required.

If the Examiner has any questions concerning this IDS, he/she is requested to contact the undersigned. If it is determined that this IDS has been filed under the wrong rule, the PTO is requested to consider this IDS under the proper rule and charge the appropriate fee to Deposit Account No. 02-2448.

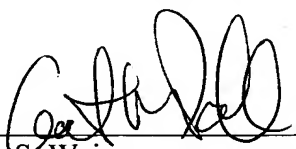
Application No.: 10/586,536

Docket No.: 0425-1266PUS1

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: *October 18, 2006*

Respectfully submitted,

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Attachment(s):

- ☒ PTO-SB08
- ☒ Documents
- ☐ Foreign Search Report
- ☐ Fee
- ☐ Other:



PTO/SB/08A/B (09-06)

Approved for use through 03/31/2007. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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|--|---|----|---|--------------------------|-------------------|
| Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary) | | | | Complete if Known | |
| | | | | Application Number | 10/586,536 |
| | | | | Filing Date | July 19, 2006 |
| | | | | First Named Inventor | Toshimitsu UENAKA |
| | | | | Art Unit | N/A |
| | | | | Examiner Name | Not Yet Assigned |
| Sheet | 1 | of | 2 | Attorney Docket Number | 0425-1266PUS1 |

| U.S. PATENT DOCUMENTS | | | | | |
|-----------------------|--------------------------|---|--------------------------------|--|---|
| Examiner Initials* | Cite No. ¹ | Document Number Number-Kind Code ² (if known) | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
| | | | | | |

| FOREIGN PATENT DOCUMENTS | | | | | | | |
|--------------------------|--------------------------|---|--|-----------------------------------|--|---|----------------|
| Examiner Initials* | Cite No. ¹ | Foreign Patent Document | | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear | T ³ |
| | | Country Code ³ -Number ⁴ -Kind Code ⁵ (if known) | | | | | |
| | BA | JP-WO 02/42493-A1 | | 05-30-2002 | | | ✓ |
| | BB | JP-WO/2004/011661 | | 02-05-2004 | | | ✓ |
| | BC | JP-WO 03/099813 | | 12-04-2003 | | | ✓ |
| | BD | JP-WO 02/060890 | | 08-08-2002 | | | ✓ |
| | BE | EP 1 336 660 | | 08-20-2003 | | | |
| | BF | EP 1 508 570 | | 02-23-2005 | | | |
| | BG | EP 1 380 579 | | 01-14-2004 | | | |

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

| NON PATENT LITERATURE DOCUMENTS | | | |
|---------------------------------|--------------------------|---|----------------|
| Examiner Initials | Cite No. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T ² |
| | CA | Birner et al., Clinical Cancer Research, Vol. 7, pp.1669-1675, June 2001 | |
| | CB | Furukawa et al., Clinical Cancer Research, Vol. 1, pp 305-311, March 1995. | |
| | CC | Kaneta et al., Japn. J. Cancer Res., Vol. 93, pp 849-856, August 2002 | |
| | CD | Kobayashi et al., Jpn. J. Cancer Res. Vol. 92, pp 203-210, February 2001 | |
| | CE | Saikawa et al., Jpn. J. Cancer Res., Vol. 85, pp 762-765, July 1994 | |
| | CF | Scherf et al., Nature Genetics, volume 24, pp 236-244, March 2000 | |
| | CG | Uenaka et al., Dai 63 Kai The Japanese Cancer Association Sokai Kiji, August 25, 2004, page 499, left column; p-1409 | ✓ |

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.

| | | | |
|-----------------------|--|--------------------|--|
| Examiner Signature | | Date Considered | |
|-----------------------|--|--------------------|--|

Birch, Stewart, Kolasch & Birch, LLP

MSW/rd